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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/830,001

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EXAMINER

NIELSEN, THOR B

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

01/31/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/830,001	<b>Applicant(s)</b> KOHUT ET AL.	
	<b>Examiner</b> THOR B. NIELSEN	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 40-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 and 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Examination**

Please note for future correspondence that the Examiner for this application has changed.

In an action mailed on December 21, 2009, all pending claims were rejected.

In a Reply dated April 20, 2010, Applicant traversed all rejections. Applicant did not include a current listing of claims in the Reply. Detailed comments on the traversal are presented below.

### **Status of Claims**

Claims 1-37 and 40-47 are under examination in the application.

Claim 1 recites:

1. A cosmetic or dermatological cleansing emulsion comprising:
    - (a) from 2 % to about 17 % by weight of at least one of sodium laureth sulfate and sodium myreth sulfate;
    - (b) from about 0.20 % to about 0.74 % by weight of one or more polyacrylates selected from anionic homopolymers and anionic copolymers of at least one of acrylic acid, an alkylated acrylic acid and esters thereof;
    - (c) from 42 % to about 51% by weight of an oil phase comprising
      - (i) from about 25 % to about 50 % by weight of a paraffin oil,
      - (ii) from about 0.5 % to about 25 % by weight of one or more oils having a polarity of from about 5 to about 50 mN/m;
- the emulsion having a viscosity of from about 500 to about 3,500 mPa s at 100 s<sup>-1</sup>.

Claims 2-27, 36, 45, 40-44, 47, and 48 depend directly or indirectly from claim 1

Claim 28 recites:

28. A cosmetic or dermatological cleansing emulsion comprising:
  - (a) from about 5 % to about 10 % by weight of at least one of sodium laureth sulfate and sodium myreth sulfate;
  - (b) from about 0.30 % to about 0.70 % by weight of one or more polyacrylates selected from anionic homopolymers and anionic copolymers of at least one of acrylic acid, an alkylated acrylic acid and esters thereof;
  - (c) from about 43 % to about 46 % by weight of an oil phase comprising
    - (i) from about 30 % to about 45 % by weight of a paraffin oil,
    - (ii) from about 5 % to about 20 % by weight of one or more oils having a polarity of from about 10 to about 45 mN/m;

the emulsion having a viscosity of from about 700 to about 3,000 mPa s at 100 s<sup>-1</sup>.

Claims 29-36 depend directly or indirectly from claim 29.

Claim 46 recites:

46. A process for making a cosmetic or dermatological cleansing emulsion, which process comprises combining  
(a) from 2 % to about 17 % by weight of at least one of sodium laureth sulfate and sodium myreth sulfate;  
(b) from about 0.20 % to about 0.74 % by weight of one or more polyacrylates selected from anionic homopolymers and anionic copolymers of at least one of acrylic acid, an alkylated acrylic acid and esters thereof;  
(c) from 42 % to about 51% by weight of an oil phase comprising  
    (i) from about 25 % to about 50 % by weight of a paraffin oil,  
    (ii) from about 0.5 % to about 25 % by weight of one or more oils having a polarity of from about 5 to about 50 mN/m;  
to form an emulsion having a viscosity of from about 500 to about 3,500 mPa s at 100 s<sup>-1</sup>.

The rejection of claims 6 and 30 over Fowler (of record) in view of Gordon (of record) and Mercier (of record) is withdrawn.

**The rejection of claims 1 - 29, 31 - 47, and 48 over Fowler (of record) in view of Gordon (of record) and Mercier (of record) is maintained.** Applicant's arguments and remarks are discussed below.

### **Response to Applicant's Remarks**

Applicant has conveniently labeled the elements of claim 1 and this Action will refer to those element labels. The previous Office Action recited how each element of the claim 1 was disclosed by the references. As a preliminary, to reiterate and clarify, examples of support for the elements in the references of record include:

- (A) Fowler, column 2, line 62;
- (B1) Fowler, column 2, line 42;

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(B2) Fowler, column 10, line 27;

(C1) Fowler, column 13, line 49 and column 16, line 10; Gordon, column 9, lines 22-24;

(C2) Fowler, column 13, line 49;

(D) Fowler, column 2, line 46;

(E1) not disclosed

(E2) Fowler, column 10, line 61;

(F1) Fowler, column 15, line 18;

(F2) Fowler, column 15, line 18;

(G) Gordon, column 8, lines 18-20.

With regard to element (E1), the previous Office Action states:

Fowler et al. do suggest that the emollient phase can be present in an amount up to 50% by weight and can contain polar lipids nonpolar lipid material, and mixtures. Further, Fowler et al. exemplify the use of both polar (i.e. cetyl alcohol, stearyl alcohol) and a paraffin oil (i.e. mineral oil) in Example 5. Thus it would have been obvious to one of ordinary skill in the art to utilize paraffin oil and polar oils in the amount instantly claimed and it is *merely routine optimization* for one of ordinary skill in the art to vary the amounts [of] each oil present in order to achieve the most stable and effective composition.

(Emphasis added.) To emphasize this aspect of the rejection, Examiner notes that Fowler discloses the amount of the oil phase and the constituents of the oil phase. In the absence of any unexpected results, adjusting the relative amounts of the

constituent oils (paraffin oil and vegetable triglycerides/ fatty acid esters, which are exemplary oils having polarity from 5 to 50 mN/m) is a routine part of optimization of the composition.

Applicant remarks that Fowler discloses hundreds of surfactants and emollients and that moreover, Fowler mentions thickeners as optional components. Applicant argues that the high number of possible combinations of ingredients does not support an obviousness rejection. In particular, Applicant cites several cases to support its argument, including *In re Baird* 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.")

Applicant further cites *In re Jones*, 21 USPQ2d 1941, 9143 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from *Merck [ & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that ... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.")

*In re Baird* is not *in point* because the case is directed to a claimed compound (i.e., *a species*), whereas Applicant's claim 1 is directed to a broad composition, i.e., a cleansing emulsion having broad ranges of many constituents. Examiner notes that *In re Jones* is directed to patentability of a species in the face of disclosure of a genus encompassing that species. *In re Jones* is not binding because it is also directed to the patentability of a species where a genus encompassing that species is disclosed.

Unlike the situation in *Jones* Applicant claims a genus that is encompassed by a larger, disclosed genus. Thus Applicant's argument is not persuasive.

Moreover, the law suggested by the Applicant as applicable is circumscribed and limited by *KSR v. Teleflex*. 550 U.S. 398 (2007). In particular, *KSR* identifies that combining prior art elements according to known methods to yield predictable results can be obvious under 35 USC 103(a). In the instant application, Applicants have combined surfactant, oil, water, and polymer thickener, all of which are constituents of known cleansing emulsions, to make a cleansing emulsion having properties that have not been distinguished from those of prior art cleansing emulsions.

*KSR* also identifies that a simple substitution of one known element for another to obtain predictable results can be obvious. Here, Applicants have substituted a mixture of paraffin oil and other oil, e.g., vegetable oil, to obtain a cleansing emulsion having properties of prior art cleansing emulsions.

*KSR* also states that choosing from a finite number of identified, predictable solutions with a reasonable expectation of success is obvious to try. In the instant invention as claimed, Applicants have tried substituting a mixture of oils in particular amounts or proportions for a single oil or mixture of unspecified proportions to achieve a cleansing emulsion having properties similar to known cleansing emulsions.

On the basis of any one, or several, of the above rationales, it would have been obvious for one of ordinary skill in the art to have prepared the cleansing emulsions as instantly claimed. Moreover, the use of such emulsions would also have been obvious.

In addition, *KSR* is not limited to the predictable arts. *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009). Formulation of cleansing emulsions may be an unpredictable art, but the determination of obviousness as stated by the Supreme Court in *KSR* still applies.

On page 4 of the Reply, Applicant begins a lengthy argument that the narrowest of the disclosures of the prior art do not disclose the instantly claimed invention. In the course of this argument, Applicant admits that Fowler discloses elements A, B2, C1, C2, E2, F1, and F2 (see listing above). Likewise, Applicant argues that specific examples in Fowler suggest a high water content. Applicant, however, does not give credence to the broad disclosure cited by the Examiner. Because Applicant is not claiming a specific species, Applicant's argument is not persuasive.

Applicant asserts that the surfactant concentrations disclosed by Fowler does not apply solely to anionic surfactants, or to sodium laureth sulfate and/or sodium myreth sulfate. *At* page 6.

Examiner takes this statement as an admission that Fowler discloses surfactant concentrations that encompass the element in claim 1.

Applicant further states that sodium myreth sulfate is not even mentioned in Fowler. *At* page 6.

As claim 1 is directed to either sodium laureth sulfate or sodium myreth sulfate, Applicant's argument is not persuasive with regard to claim 1 or other claims permitting sodium laureth sulfate as surfactant.

Applicant continues on page 6 of the Reply with the argument based on the exemplary disclosure of Fowler or on preferred compositions. The argument is not



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persuasive, because it ignores the broad disclosure by Fowler, as cited by the Examiner.

In the course of the argument, Applicant admits that Fowler discloses the elements C1 and C2 of claim 1.

Applicant turns to the teachings of Gordon and Mercier and admits that Gordon overlaps (i.e. discloses) element G of claim 1. At page 8.

Examiner construes Applicant's argument to imply an assertion of the patentability of claims 6 and 30, because Fowler does not disclose sodium myreth sulfate and the deficiency is not cured by either Gordon or Mercier. Examiner concurs with this implied argument.

**The rejection of claims 17 and 33 over Fowler (of record) in view of Gordon (of record) and Mercier (of record) and further in view of McLaughlin (of record) is maintained.** Applicant's arguments and remarks are discussed below.

Applicant does not provide new arguments for the patentability of claims 17 and 33, other than those provided above.

Applicant's arguments with regard to claim 17 and 33 are not persuasive for the reasons provided above.

## **New Rejections**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (of record) in view of Gordon (of record) in view of US 5585104 (Ha). The reference was published more than a year before the filing date of the instant application.

### **Scope of the claims**

The claims are discussed above.

### **Scope of the disclosure of the prior art**

The disclosures of Fowler and Gordon are presented above and are of record. Ha is directed to **cleansing emulsions comprising surfactant, polymers of acrylic acid, oil and water, and to a method of use of the emulsions**. Column 2, lines 27-67. Ha teaches that the surfactant can be **sodium myreth sulfate** or **sodium laureth sulfate**. Column 12, line 56 to column 13, line 2.

### **Ascertainment of the difference between the prior art and the claims**

The combination of Fowler and Gordon does not teach that sodium myreth sulfate can be used as a surfactant. Ha teaches sodium myreth sulfate as a surfactant in cleansing emulsion compositions and thus cures the deficiency.

### **Finding of prima facie obviousness**

One of ordinary skill in the art, upon reading Fowler and Gordon would have found it obvious to consider other surfactants that could be used and could have turned to Ha for relevant teachings, because Ha is also directed to cleansing emulsions.

### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOR B. NIELSEN whose telephone number is (571)270-3476. The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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